



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,165	08/09/2000	Zeeman Zhang	00297	5726

7590 02/03/2003

Mark G Knedeisen Esq
Kirkpatrick & Lockhart LLP
Henry W Oliver Building
535 Smithfield Street
Pittsburgh, PA 15222-2312

EXAMINER

KIDD, MARKY M

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 02/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/635,165

Applicant(s)

ZHANG ET AL.

Examiner

Marky M Kidd

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☒ Claim(s) 22 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 22 recites the limitation "the method of claim 26". However, claim 26 is an apparatus claim. Therefore, the preamble of this claim is confusing. Furthermore, claim 26 can't be the parent claim of its preceding claim 22. The examiner is going to assume that the applicant intended for claim 22 to depend on claim 20 for the purposes of rejections in this action.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1, 2, 8, 9, 16, and 20-28** are rejected under 35 U.S.C. 102(b) as being unpatentable by Daudelin (US Patent Number 4,959,855).
5. Regarding **claim 1**, Daudelin discloses a telecommunication switching system consisting of:

A switch (local switch 30) in communication with a telecommunication device (calling terminal 40 and 42) associated with the telecommunications user for detecting a trigger specific

Art Unit: 2645

to the service in response to a communication from the telecommunications device (column 3, lines 52-57) and for routing the communication to an operator services system (DAS/C 56) in response to detection of the trigger (column 4, lines 6-13); and

An intelligent resource server (switch 1) in communication with the switch (local switch 30) for receiving via the switch (local switch 30) the communication from the operator services system (DAS/C 56) with a message including information regarding a party requested by the telecommunications user in response to receiving the communication (column 7, line 6 and claim 1), the audible message containing the information regarding the party (column 7, line 44) and for automatically recognizing a predetermined keyword spoken by the telecommunications user in response to the audible message (column 8, lines 6-8).

Regarding **claim 8**, Daudelin discloses a telecommunication switching system that consist of the following:

A switch (local switch 30) in communication with a telecommunications device (calling terminal 40) associated with the telecommunications user for detecting a trigger specific to the service in response to a communication from the telecommunications device and for routing the communication to an operator services system in response to detection of the trigger (column 3 line 52-57 and column 4, lines 6-13);

A call processing module (voice processing unit 14) in communication with the switch for receiving via the switch the communication from the operator services system (DAS/C) with a message including information regarding a party requested by the telecommunications user from the operator services system (column 7, line 44);

Art Unit: 2645

An enunciation module (voice processing unit 14) in communication with the call processing module for playing an audible message for the telecommunications user in response to receiving the communication, the audible message containing the information regarding the party and prompting the telecommunications user to place an outgoing communication to the party (column 8, line 6 and Figure 3 item 210); and

An automatic speech recognition module in communication with the switch for recognizing a predetermined keyword spoken by the telecommunications user in response to the audible message (column 8, line 7 and Figure 4 item 230).

As far as the call processing module, enunciation module, and automatic speech recognition module Daudelin discloses a method of combining the voice processing unit 14 and the audio response unit 60 in order to make one unit (column 5, line 9).

Regarding **claim 16**, Daudelin discloses an voice processing unit 14 for providing a telecommunications service with automatic speech recognition for a telecommunications user, consisting of:

A call processing module (voice processing unit 14) for receiving via a switch in communication with a telecommunications device (calling terminal 40) associated with the telecommunications user a communication from an operator services system with a message including information regarding a party about whom the telecommunications user requested information from the operator services system (column 7, line 44).

An enunciation module (voice processing unit 14) in communication with the call processing module for playing an audible message for the telecommunications user in response to receiving the communication, the audible message containing the information regarding the

Art Unit: 2645

party and prompting the telecommunications user to place an outgoing communication to the party (column 8, line 6 and Figure 3 item 210); and

An automatic speech recognition module in communication with the switch for recognizing a predetermined keyword spoken by the telecommunications user in response to the audible message (column 8, line 7 and Figure 4 item 230).

Regarding **claim 20**, Daudelin discloses a method for providing a telecommunication switching network with automatic speech recognition to a telecommunications user consisting of:

Detecting a communication (customer's request) from the telecommunications user (column 6, line 65-67);

Providing information requested by the telecommunications user regarding a party upon detection of the communication (column 7, lines 2-6);

Playing an audible message for the telecommunications user containing the information regarding the party (column 7, lines 44-45) and prompting the telecommunications user to place an outgoing communication to the party (column 8, lines 6-7);

Recognizing a predetermined keyword spoken by the telecommunications user in response to the audible message (column 8, line 8 and lines 16-21).

Regarding **claim 24**, Daudelin discloses a method for providing a telecommunication switching network with automatic speech recognition to a telecommunications user consisting of:

Detecting a communication from the telecommunications user (column 6, line 65-67);

Playing an audible message for the telecommunications user containing the information

Art Unit: 2645

regarding the party (column 7, lines 44-45) and prompting the telecommunications user to place an outgoing communication to the party (column 8, lines 6-7);

Recognizing a predetermined keyword spoken by the telecommunications user in response to the audible message (column 8, line 8 and lines 16-21).

Regarding **claims 2 and 9**, Daudelin further discloses the switch includes a switch of a central office in communication with the telecommunications device via a subscriber line (column 4, line 2).

Regarding **claims 21 and 26**, Daudelin discloses placing the outgoing communication to the party based on recognition of the predetermined keyword (column 8, lines 16-21).

Regarding **claims 22 and 27**, Daudelin discloses recognizing a predetermined DTMF character entered by the telecommunications user in response to the audible message (column 8, lines 34-37).

Regarding **claims 23 and 28**, Daudelin discloses placing the outgoing communication to the party based on recognition of the predetermined DTMF character (column 8, lines 64-67).

Regarding **claim 25**, Daudelin discloses providing information requested by the telecommunications user regarding the party upon detection of the communication (column 6, lines 65-67 and column 7, lines 2-6).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a

Art Unit: 2645

whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 4-7, 11-15, and 17-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik (US Patent Number 5,943,409) in view of Daudelin (US Patent Number 4,959,855).

Regarding **claims 4 and 11**, Daudelin discloses a telecommunications switching network consisting of a switch (local switch 30). Daudelin; however, is silent on the issue of the switch detecting an originating trigger in response to a feature code entered by the telecommunications user from the telecommunications device. Malik discloses a automatic recall system equipped with a ability to causes a trigger within the originating switch based on a feature code provided by the calling party (column 3, lines 31-40). It would have been obvious at the time of the invention to modify the method of Daudelin to incorporate the method of Malik in order to allow different callers to trigger the local switch based off of feature codes.

Regarding **claims 5 and 12**, Daudelin discloses a telecommunication switching network that consisting of a switch routing communication from the telecommunications device upon detecting a trigger, and routing the communication from the operator services system to the intelligent services system (DAS/C 56). Daudelin, however, is silent on the issue of the switch communicating with a service control point. Malik discloses a service control point (SCP 50) in communication with the central office switch (SCP 25a and 25b) by means of subscriber lines (20a and 20b, column 5, line 6 and lines 13-17). It would have been obvious to one skilled in the art at the time of the invention to modify the network of Daudelin to incorporate the network of Malik in order to allow an Advanced Intelligent Network. Therefore, allowing an enhanced telecommunications services to callers.

Art Unit: 2645

Regarding **claims 6, 13 and 17**, placing the outgoing communication to the party based on recognition of the predetermined keywords are addressed as limitations of claim 1 (Daudelin column 7, lines 4-7, column 8 lines 8-12 and lines 16-21). Therefore, the claim is rejected for the same reasons.

Regarding **claims 7, 14 and 18**, Both Malik and Daudelin discloses a network that recognizes DTMF signal recognition (Malik column 6, lines 59 and Daudelin column 8, lines 62-64) for the placing an outgoing communication to the party upon recognizing the DTMF character entered by the telecommunications user.

Regarding **claims 15 and 19**, Malik and Daudelin discloses a call processing module that is further for placing the outgoing communication based on recognition of the predetermined DTMF character by the DTMF decoder module (Malik:service circuit node 55 column 6, line 58, Daudelin: voice processing unit 14 column 8, line 61).

7. **Claims 3 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Daudelin in view of Batni (US Patent Number 5,898,917).

Regarding **claim 3 and 10**, Daudelin disclose all the limits as set forth in claim 1. However, Daudelin is silent on the issue of the switch including a mobile switching center in communication with the telecommunications device via an air-interface communication scheme. Batni discloses a cellular radio telecommunications system that provides enhanced services from an SCP (Figure 1 and column 3, lines 37-39). Therefore, it would have been obvious to one skilled in the art at the time of the invention to expand the network of Daudelin to include a wireless network.

Art Unit: 2645

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. **Claims 1-28** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-23 of U.S. Patent No. 6,505,163. Although the conflicting claims are not identical, they are not patentably distinct from each other because subject matter claimed in application 09/635165 are so well known in the art that minor changes to the network would have been obvious and provide the network patented in '163. For example, claim 20 of the present invention is the same as claim 17 of the patent except that the pending claim 20 recited "a party", and the patented claim 17 recited "a prior calling party". Therefore, claim ²⁰ of the present invention is broader than claim 17 of the patent.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marky M Kidd whose telephone number is 703-305-8149. The examiner can normally be reached on Monday-Friday 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone numbers for the

Art Unit: 2645

organization where this application or proceeding is assigned are 703-308-5403 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

Marky M Kidd
Examiner
Art Unit 2645

January 24, 2003

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read 'Fan Tsang', with a long horizontal stroke extending to the right.